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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,762	10/23/2003	John Lawrence Colley	DOMINION 2	6688
31704	7590	09/30/2009		
Thomas, Raring, & Teague, P.C. 536 GRANITE AVENUE RICHMOND, VA 23226			EXAMINER LUBIN, VALERIE	
			ART UNIT 3626	PAPER NUMBER
			MAIL DATE 09/30/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/691,762	<b>Applicant(s)</b> COLLEY ET AL.	
	<b>Examiner</b> VALERIE LUBIN	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/5/04</u> .  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of claims 1-10 in the reply filed on 06/09/09 is acknowledged.

Claims 1-10 are pending

For reference purposes, the document paper number is 20090903

***Allowable Subject Matter***

2. Claims 6 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

For claim 6, Ryan discloses accounting for differences in co-payment or coinsurance amounts between insurance products (Col. 4 lines 41-46, col. 6 lines 21-28, e.g. conducting sensitivity analysis on the insurance products to account for differences in premium amounts) and Harrison does disclose multiplying premium variables by an adjustor. However, the prior art does not recite: a) multiplying co-payment or coinsurance payment increments and decrements by typical utilization or cost levels; and (b) multiplying the result of step(a) by a behavioral multiplier for a type of service.

With respect to claim 8, Ryan discloses conducting sensitivity analysis on insurance products which is a form of assessment (Col. 6 lines 21-28); however, the claim distinguish over the prior art in that it recites limitations such as generating log normal distributions,

derivative out-of-pocket costs and modeling deductibles and out-of-pocket maxima at a plurality of claim levels.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claims 1-10 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must (1) be tied to a particular apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); and *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the apparatus that accomplishes the method steps, by positively reciting the subject matter that is being transformed, or by identifying the material that is being changed to a different state.

Applicant's method steps in claims 1 fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Furthermore, the method steps fail to transform underlying subject matter to a different state or thing.

Claims 2-10 as dependents of claim 1 are rejected under the same analysis.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 1 recites assigning a standard value to an insurance product, calculating a value index for a selected alternative product and comparing the index value of the alternative product to the standard insurance product. The claim is indefinite as it is unclear how Applicant is comparing two insurance products using different measures, i.e. a standard value of one product versus the index value of the other.

Claims 2-10, as dependents of claim 1, are rejected under the same analysis.

9. Claim 6 recites “the calculation of the expected premium impact...” in the preamble.

There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-3 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ryan et al. U.S. Patent No. 5,655,085.

12. With respect to claim 1, Ryan teaches a method comprising the step of selecting one or more insurance products (Col. 18 lines 33-36; col. 19 lines 46-53) which is a form of selecting a standard product and selecting an alternative product; assigning a value to an insurance product (Col. 1 lines 45-49); calculating a value index for insurance products (Col. 21 lines 58-60); and using the index to compare the insurance products (Col. 21 lines 58-67; col. 22 lines 1-46).

Claim 2 is rejected under the analysis of claim 1.

13. Claim 3 is rejected, as Ryan discloses the insurance product being an incumbent one (Col. 8 lines 9-13; col. 22 lines 52-62).

14. Regarding claim 10, Ryan teaches a value index being a single number (Fig. 27E).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al. U.S. Patent No. 5,655,085.

17. With respect to claim 4, Ryan recites calculating a value index for insurance products (Col. 21 lines 58-60). He does not recite that the index is the ratio of an expected premium to an actual premium; however, this is simply the substitution of known elements in the art for other elements that produced predictable results (Ex-parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)). The claim is therefore rendered obvious over the prior art.

18. With respect to claim 5, Ryan discloses accounting for differences in co-payment or coinsurance amounts between insurance products (Col. 4 lines 41-46, col. 6 lines 21-28, e.g. conducting sensitivity analysis on the insurance products to account for differences in premium amounts).

Claim 7 is rejected under the analysis of claim 5.

19. With respect to claim 8, Ryan discloses conducting sensitivity analysis on insurance products which is a form of assessment (Col. 6 lines 21-28). The mathematical steps used in conducting such analysis or assessment is a mere substitution of known techniques for others that yield predictable results (Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)).

20. Claim 9 is rejected as Ryan discloses assigning a discretionary premium impact value for a predetermined benefit difference between insurance products (Col. 2 lines 61-63).

### ***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Harrison U.S. Pre-Grant Pub No. 2003/0078817 recites multiplying premium variables by an adjustor.



22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. L./  
Examiner, Art Unit 3626

/C. Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626